

Serial No. 10/073,987
August 27, 2003
Reply to the Office Action dated February 27, 2003
Page 6 of 10

REMARKS/ARGUMENTS

Claims 1-19 are pending in this application. By this Amendment, Applicant AMENDS claims 1-12, 14, 15, and 17. The Examiner has withdrawn from consideration claims 4-6, 9, 11, 17, and 19.

Please note, the Examiner has indicated in line 4a) on Form PTO-326 that claim 8 was withdrawn from consideration. However, Applicant believes that this was inadvertent because (a) the Examiner has rejected claim 8 under 35 U.S.C. §112, second paragraph and under 35 U.S.C. §103(a); (b) the Examiner did not include claim 8 in paragraph no. 2 on page 2 of the Office Action where the Examiner withdrew claims 4-6, 9, 11, 17, and 19; and (c) claim 8 is directed to the elected species. Accordingly, Applicant respectfully requests that the Examiner clarify this issue in the next Office Action.

Applicant affirms election of Species I, including **Figs. 1 and 2**. The Examiner has alleged that there are no generic claims in paragraph no. 2 in the outstanding Office Action and in the Restriction Requirement, dated January 23, 2003. Applicant cannot more strongly disagree.

MPEP § 806.04(d) states that a generic claim:

(a) should read on all the species; AND

(b) cannot include features not present in each of the added species claims.

By definition, an independent claim is generic to all of its dependent claims. Applicant's claim 1 is clearly generic because (a) claim 1 reads on each of the species indicated by the Examiner, **Figs. 1 and 2, Fig. 3, Fig. 4, and Fig. 5**; and (b) claim 1 does not include any features not present in each of the species.

Accordingly, Applicant respectfully requests that the Examiner consider and allow withdrawn claims 4-6, 9, 11, 17, and 19 when generic claim 1 is allowed.

Claims 1-3, 7, 8, 10, 12-16, 18, and 19 were rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite.

The Examiner has rejected claim 1 because allegedly the phrase "the coil

Serial No. 10/073,987
August 27, 2003
Reply to the Office Action dated February 27, 2003
Page 7 of 10

included at least two kinds of the coil conductor patterns which have a different number of turns" should be clarified. Applicant has amended claim 1 to correct this alleged informality noted by the Examiner.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-3, 7, 8, 10, 12-16, 18, and 19 were rejected under 35 U.S.C. §112, second paragraph.

Claims 1-3, 8, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Person et al. (U.S. 5,880,662) in view of Williams (U.S. 4,873,757). Claims 7, 10 and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Person et al. in view of Williams, and further in view of Grandmont et al. (U.S. 5,781,093). Applicant respectfully traverses the rejections of claims 1-4 and 7-10.

Claim 1 has been amended to recite:

"Claim 1 (currently amended): A laminated inductor comprising:
a laminated body including a plurality of insulation layers and a plurality of coil conductor patterns having at least one turn and being stacked on each other in a lamination direction with the insulation layers being disposed therebetween; wherein
the plurality of coil conductor patterns are electrically connected to define a coil, the plurality of coil conductor patterns of the coil includes at least a first kind and a second kind of the coil conductor patterns, and the first kind of the coil conductor patterns has a different number of turns from the second kind of the coil conductor patterns; and
said first kind and said second kind of the coil conductor patterns are connected in series." (emphasis added)

Applicant's claim 1 recites the features of "the plurality of coil conductor patterns of the coil includes at least a first kind and second kind of the coil conductor patterns," "the first kind of the coil conductor patterns has a different number of turns from the second kind of the coil conductor patterns," and "said first kind and said second kind of the coil conductor patterns are connected in series." With the improved features of claim 1, Applicant has been able to provide a laminated inductor in which the degree of

Serial No. 10/073,987
August 27, 2003
Reply to the Office Action dated February 27, 2003
Page 8 of 10

design freedom is very high and the best characteristics can be easily obtained (see, for example, the first full paragraph on page 2 of the Specification).

Applicant agrees with the Examiner that Person et al. shows a laminated inductor and does not show "the coil conductor patterns having a *different number of turns*" (emphasis in original) (second to last paragraph on page 3 of the Office Action). The Examiner has relied upon Williams to cure this deficiency of Person et al.

First, the Examiner has failed to provide a proper reason for combining the teachings of Williams and Person et al. The Examiner has alleged in the first paragraph on page 4 of the Office Action that it would have been obvious to modify the teachings of Person et al. in view of the teachings of Williams "for the purpose of controlling the inductance."

Applicant is completely bewildered as to why the motivation of "controlling the inductance" would lead specifically to a modification of Person et al. to include a first kind of coil conductor pattern which has a different number of turns from a second kind of the coil conductor pattern in a single coil as recited in Applicant's claim 1. Person et al. clearly teaches in lines 46-49 of column 3 that additional dielectric layers can be added in order to "control the inductance." That is, the Examiner has completely failed to explain why the motivation of "controlling the inductance" would necessarily lead to providing a first kind of coil conductor pattern which has a different number of turns from a second kind of the coil conductor pattern in a single coil as recited in Applicant's claim 1.

Second, even assuming *arguendo* the Person et al. and Williams could be combined, Williams clearly fails to teach "the plurality of coil conductor patterns of the coil includes at least a first kind and second kind of the coil conductor patterns" and "the first kind of the coil conductor patterns has a different number of turns from the second kind of the coil conductor patterns" as recited in Applicant's claim 1. Williams clearly teaches different coils which include coil conductor patterns which have a different number turns from the coil conductor patterns of the other coils, NOT that a single coil

Serial No. 10/073,987
August 27, 2003
Reply to the Office Action dated February 27, 2003
Page 9 of 10

includes a first kind of coil conductor patterns which has a different number of coils from a second kind of coil conductor patterns of the same coil as recited in Applicant's claim 1. Further, Williams clearly teaches that the different kinds of coil conductor patterns are not connected, NOT that two kinds of the coil conductor patterns are connected in series as recited in Applicants' claim 1.

Drawing sheets 2-5 of Williams each show a different coil. Sheet 2 shows coil SY2; Sheet 3 shows coil SY1; Sheet 4 shows coil PY1; and Sheet 5 shows coil SY3 (lines 43-47 of column 2 of Williams). Each of the coils SY1-3 and PY1 is clearly electrically isolated from the other coils, i.e. each is not connected in series. Contrary to the Examiner's allegation, Williams does not teach or suggest the features of "the plurality of coil conductor patterns of the coil includes at least a first kind and second kind of the coil conductor patterns," "the first kind of the coil conductor patterns has a different number of turns from the second kind of the coil conductor patterns," and "said first kind and said second kind of the coil conductor patterns are connected in series" as recited in Applicant's claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) as being obvious over Persons et al. in view of Williams.

The Examiner has relied upon Grandmont et al. to cure various deficiencies in the combination of Persons et al. and Williams. However, Grandmont et al. clearly fails to teach or suggest the features of "the plurality of coil conductor patterns of the coil includes at least a first kind and second kind of the coil conductor patterns," "the first kind of the coil conductor patterns has a different number of turns from the second kind of the coil conductor patterns," and "said first kind and said second kind of the coil conductor patterns are connected in series" as recited in Applicant's claim 1.

Accordingly, Applicant respectfully submits that Persons et al., Williams, and Grandmont et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in claim 1 of the present application.

Serial No. 10/073,987

August 27, 2003

Reply to the Office Action dated February 27, 2003

Page 10 of 10

Claims 2, 3, 7, 8, 10, 12-16, 18, and 19 depend upon claim 1 and are therefore allowable for at least the reasons that claim 1 is allowable. As discussed above, Applicant respectfully submits that claims 4-6, 9, 11, 17, and 19 are allowable because generic claim 1 is allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a Three-month extension of time, extending to August 27, 2003, the period for response to the Office Action dated February 27, 2003.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: August 27, 2003


Attorneys for Applicant

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030
Telephone: (703) 385-5200
Facsimile: (703) 385-5080